REMARKS

This is a full and timely response to the outstanding final Office Action mailed October 21, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(b)

Claims 11-14 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Levine, et al. ("Levine," U.S. Pat. No. 5,974,234). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, *every claimed feature* of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the Levine reference. Applicant discusses various aspects of the rejection in the following.

A. "Accessing a Thin Print Server Having No Physical Interface"

As was noted in the previous Response, Applicant amended claim 11 to recite a "thin print server having no physical user interface". Applicant again asserts that Levine teaches no such thin print server. In contrast, Levine discloses a proxy server 107A that couples clients with document processing devices. At no point in the Levine disclosure is the proxy server described as a thin server or thin print server.

In response to the Examiner's contention that Levine does teach a thin print server because Levine does not explicitly identify a physical user interface, Applicant notes that Levine's omission as to whether a physical user interface is or is not present does *not* establish that Levine's proxy server does in fact comprise no such physical user interface and, therefore, is only accessed via network communications. Applicant notes that Applicant's explicit recital of a thin print server that does not comprise a physical user interface must be identified in the reference for a proper rejection under 35 U.S.C. § 102.

Applicant further reiterates that the difference between a general purpose server (such as that disclosed by Levine) and a thin server is significant to persons having ordinary skill in the art. Again, as is described by Applicant on page 12, lines 5-18 of the application (emphasis added):

> as a thin server, the network print appliance 402 is ***optimized to deliver only the capabilities for which it is designed, without including unnecessary software or hardware features related to other general purpose network servers or computers***. For example, the network print appliance 402 is designed to be accessed, managed, and utilized from remote locations only, such as from a remote computer 404 or remote server 408, and therefore provides no physical user interface. Thus, elements described above pertaining to computer 404 that are typically not a part of the appliance 402 include various input devices, such as the keyboard 534, pointing device 536, microphone, joystick, game pad, satellite dish, scanner, and the like. Other elements described above pertaining to computer 404 which are not typically a part of the network print appliance 402 include the display device and other peripheral output devices such as speakers.

Further of significance is that Applicant's thin server provides the functionality of both a printer server and a printer administration tool. As is described on page 17, line 22 to page 18, line 8 of Applicant's specification (emphasis added):

> Therefore, a preferred implementation of the network print appliance 402 includes the Hewlett Packard JetDirect 4000 Print Appliance executing the printer server module 616 along with a pre-installed version of the Hewlett Packard Web JetAdmin software product modified to, (1) support only the operating system 614 on the network print appliance 402, and (2) create shared network print objects 620 only on the network print appliance 402 itself, and not on any general-purpose network server 408 or computer 404. ***The network print appliance 402 thus combines both thin print server functionality with network printer administration functionality, while retaining the small, lightweight, cost saving, characteristics common with most thin servers. This, and the minimal configuration required by the network print appliance 402, make it easy to move and install practically anywhere on the network without affecting any other servers on the network.***

Simply stated, the Office Action has not identified any such features of Levine's proxy server. The Office Action therefore has not established that Levine discloses a thin server.

As a further point, Applicant notes that the term "thin server" is a recognized term in the applicable art. As proof of this fact, a Google™ search conducted for the term "thin server" at the time of drafting this Response yielded about 9,970 hits. To ignore Applicant's express recital of a thin print server is to disregard an explicit limitation of Applicant's claim. Because Levine provides no such teaching or

suggestion of such a component, Applicant respectfully submits that Levine cannot anticipate or render obvious Applicant's claims 11-14.

B. Discovering Printers and Creating Shared Network Print Objects

Levine further fails to disclose "managing the thin print server such that the thin print server discovers one or more printers connected to the network and creates one or more shared network print objects, each shared network print object representing a printer connected to the network as a shared network printer", as is explicitly recited in Applicant's independent claim 11.

In support of the position that Levine does teach such management of a print server and discovery of printers connected to a network, the Office Action identifies column 17, lines 30-46 of the Levine reference. That portion of the Levine reference provides as follows:

> Discovery or Installation Commands
>
> AddDevice (LPCTSTR DeviceName, LPCTSTR IPAddress, LPCTSTR DeviceType)
>
> For each device to be added, an LPR Port and a LPR queue associated with the device are set up on the NT Server. The program started by the AddDevice request adds the LPR Port and associated LPR queue for the device being added and loads an appropriate driver for the device.
>
> DeleteDeviceSettings(LPCTSTR DeviceName)
>
> The NT Server removes (1) an LPR Port and Queue, both of which correspond to the device being deleted, (2) any registry entries associated with the device, and (3) an appropriate entry from the file in the NT Server, the entry corresponding with the device.

Although this excerpt of the Levine reference does include the term "Discovery," it is clear that it simply does not describe "managing the thin print server such that the thin print server discovers one or more printers connected to the network and creates one or more shared network print objects, each shared network print object representing a printer connected to the network as a shared network printer" as is explicitly recited in claim 11. Again, anticipation requires the disclosure in a single prior art reference of *each element* of the claim under consideration. *W. L. Gore & Associates*, 721 F.2d 1540, 220 USPQ 303. Applicant's claims are allowable over Levine for this reason also.

C. Dependent Claims

In addition to failing to teach or suggest several limitations of independent claim 11, Levine further fails to teach or suggest limitations contained in the claims that depend from claim 11. For example, regarding dependent claim 12, Levine does not teach or suggest a method in which a thin server "is required to create the one or more shared network print objects", "thereby preventing the creation of a shared network print object on any other network device".

D. Conclusion

Due at least to the above-noted shortcomings of the Levine reference, Applicant respectfully asserts that Levine does not anticipate Applicant's claims 11-14. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Mansbery, et al. ("Mansbery," U.S. Pat. No. 6,121,593) in view of Levine. Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

In the present case, there is no suggestion or motivation to combine the references or make the modifications proposed in the Office Action. Furthermore, the prior art references, when combined, do not teach or suggest all of Applicant's claim

limitations. Applicant discusses the applied references and Applicant's claims in the following.

A. The Mansbery Disclosure

Mansbery discloses a control system that is used to control home appliances, such as a refrigerator and oven. As is described by Mansbery (column 1, lines 11-40):

> Many families today have two wage earners and as a consequence, there can be a significant delay when they both return from work before the evening meal can be prepared. Not only that, but sometimes their schedules change during the day so that the time when the evening meal is to be prepared must be changed. . . . The instant invention contemplates the remote actuation of home appliances using a specific control system. The invention also contemplates the concept of actuating a combination cooling and heating mechanism from a remote location so that food may be preserved in a refrigerated state during a finite period of time and then the refrigeration may be turned off and the cooking system may be actuated from a remote location.

In view of the above, it is clear that the Mansbery disclosure is only directed to the problem of remotely controlling home appliances, such as a refrigerator/oven appliance, for purposes of meal preparation. Because of this fact, it is difficult to understand how the Mansbery reference can serve as a base reference in a rejection against claims to a "network print appliance" or a "system for printing over a network".

B. Applicant's Claimed Inventions

Irrespective of whether the Mansbery disclosure is an appropriate reference to cite against Applicant's claims, Applicant notes that the Mansbery disclosure is deficient as to many explicitly recited features of Applicant's claims.

1. Claims 1-5

With reference first to Applicant's independent claim 1, Applicant recites (emphasis added):

> 1. A ***thin print server having no physical user interface,*** the thin print server comprising:
>
> one or more processors;
>
> a memory associated with the one or more processors;
>
> a network interface providing full-time connection to a network and remote access to the thin print server by one or more client computers;
>
> a user interface module stored in the memory and executable on the one or more processors providing remote management of the thin print server by the one or more client computers, the user interface module precluding local management of the thin print server;
>
> a ***printer administration module*** stored in the memory and executable on the one or more processors for discovering one or more printers connected to the network and creating one or more shared network print objects, each shared network print object representing a printer connected to the network as a shared network printer; and
>
> a ***printer serving module*** stored in the memory and executable on the one or more processors for receiving print jobs,

managing print queues, and forwarding print jobs to a shared network printer for printing.

(a) "Thin Print Server Having No Physical User Interface"

As a first matter, Applicant notes that because Mansbery is directed to meal preparation control, Mansbery does not teach or suggest a "thin print server having no physical user interface". First, Mansbery says nothing whatsoever about printing. Therefore, there is no support for the proposition that Mansbery teaches a "print" server. Second, Applicant notes that Mansbery does not teach or suggest a "thin print server". Applicant refers the Examiner to the discussion of the significance of the term "thin print server" provided above in relation to the rejections under 35 U.S.C. 102 above. Third, Mansbery does not teach or suggest a thin server that has "no physical user interface". To the contrary, Mansbery explicitly shows and describes elements that comprise such an interface used in conjunction with Mansbery's "computer." For example, Mansbery shows a keyboard 23 and a display 22 in Figure 1. Significantly, there is no teaching contained in either the Mansbery reference or the Levine reference for removing Mansbery's physical user interface.

(b) "Administration Module" and "Serving Module"

Contrary to that alleged in the Office Action, Mansbery also does not teach or suggest a "printer administration module" or a "printer serving module". This is understandable given that Mansbery is not concerned about printing. This fact raises the question: If Mansbery is silent as to printing, how can Mansbery teach a *printer*

administration module or a *printer* serving module? This question, which was raised in the previous Response, still has not been answered by the Examiner.

With specific regard to the printer administration module, Mansbery also fails to teach or suggest a module for "discovering one or more printers connected to the network" or "creating one or more shared network print objects, each shared network print object representing a printer connected to the network as a shared network printer". Again, since Mansbery's invention is not concerned with printing, there would be no reason to provide a module that performs those functions.

Regarding the printer serving module, Mansbery fails to teach or suggest a module for "receiving print jobs, managing print queues, and forwarding print jobs to a shared network printer for printing". Once more, because Mansbery is not concerned with printing, it follows that Mansbery's system includes no module that performs those printing functions.

(c) Combination with the Levine Reference

In recognition of the fact that the Mansbery system does not perform the various printing-related actions recited in Applicant's claims, the Office Action combines the Levine reference with the Mansberry reference to reject Applicant's claims. In the Office Action, it is argued:

> It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the network appliance taught by Mansbery to include details of a printer server as taught by Levine so that the network appliance can manage printers and print jobs remotely (Mansbery, column 4, lines 38-42; column 4, lines 1-5).

Applicant respectfully questions the logic of this argument. Specifically, Applicant questions why a person having ordinary skill in the art would be motivated to "modify" the Mansbery system to manage printers and print jobs. If such a modification were made, the Mansbery system would fail to perform the core function for which it was designed: to enable remote meal preparation. Therefore, the proposed modification would disable the primary functionality of the Mansbery system.

If the Office Action is suggesting mere addition of the print control functionality to the Mansbery system, Applicant questions why a person having ordinary skill in the art would be motivated to append such a functionality to a meal preparation control system. Is the argument that a home owner could start a meal and print a document from a remote location? Such a combination simply does not make sense. Applicant respectfully submits that a person having ordinary skill in the art would not consider such a modification without hindsight to Applicant's own disclosure or claims. Such use of hindsight to the applicant's invention is improper in formulating a rejection of the applicant's claims.

(d) Dependent Claims

Applicant further notes that the claims that depend from claim 1 contain further limitations that are not taught or suggested by either Mansbery or Levine. For instance, with reference to claim 3, Applicant notes that neither Mansbery nor Levine teach a module that "is required to create the one or more shared network print objects . . . thereby preventing the creation of a shared network print object on any other network device". In addition, regarding claim 4, Mansbery and Levine fail to teach a "printer administration module that is pre-installed". Applicant respectfully submits

that the "pre-installed" recitation comprises an explicit limitation that cannot be ignored when formulating a rejection of claim 4.

(e) Conclusion

In view of the above, Applicant respectfully submits that claims 1-5 are allowable over Mansbery and Levine. Applicant therefore respectfully requests that the rejection as to claims 1-5 is withdrawn.

2. Claims 6-10

Regarding independent claim 6 and its dependents, Applicant asserts that neither Mansbery nor Levine teach or suggest a "thin print server having no physical user interface" that is configured to "discover the one or more network printers and create one or more shared network print objects, each shared network print object representing a network printer connected to the network as a shared network printer" as is required by independent claim 6, a thin print server that is "required to create the one or more shared network print objects on the thin print server itself, thereby preventing the creation of a shared network print object on any other network device" as is required by claim 8, or a "printer administration module being pre-installed on the thin print server" as is required by claim 9, for reasons described above in relation to the rejection of claims 1-5.

In view of the foregoing, it is respectfully submitted that each of claims 6-10 are also patentable over Mansbery/Levine and that the rejection of these claims should be withdrawn.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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